

REMARKS

Claims 1-43 were previously pending in this application. Claims 1, 12, 25 and 36 have been amended. As a result claims 1-43 are pending for examination with claims 1, 12, and 25 being independent claims. No new matter has been added.

Examiner Interview

Applicant wishes to thank Examiner Harper and Examiner Laneau for the courtesies extended to Applicant's Representative during the course of the Interview on November 3, 2009. During the course of the Interview, Applicant's Representative and Examiners discussed the pending Office Action, and in particular the rejection of claims 1 and 25 under §112. Applicant's Representative presented various recitations of support for the claim language, although agreement was not reached, the Examiner agreed to consider written submission of the examples and what would be conveyed to one of skill in the art.

Additionally, Applicant's Representative and Examiners discussed the rejection of the claims over the references of record, with particular reference to Fisk. Examiner Harper clarified that the rejection was based upon what one of skill in the art would infer from Fisk in combination with the teachings of Itkis. In the Interview, Examiner Harper proposed that one of skill in the art would infer that the reference to promotion in Fisk (p. 13 and 14) would implicate all other types of promotion. Also Examiner Harper proposed that because Itkis is a promotional type game, one of skill in the art would seek to combine Fisk and Itkis in way that renders the claims obvious. Applicant's Representative respectfully submitted that Itkis discloses a free-only game. Further, Itkis indicates that it is an object of the invention to provide a free-only game. In addition, Applicant's Representative argued that it would not be proper to modify a reference so as to defeat the stated objects of the invention. Examiner Harper disagreed, indicating regardless of the objects of the invention that would be defeated by the proposed modification, that a teaching away only occurs when a reference explicitly indicates that it can not work in combination with the other reference. Applicant's Representative respectfully disagrees with the Examiner's understanding of teaching away as further outlined below. Accordingly, Applicant submits this Response for the Examiner's consideration.

Rejection under 35 U.S.C. §112

The Office Action rejected claims 1 and 25 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The standard for determining compliance with the written description requirement is provided by MPEP 2163.02, which instructs that the “objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’” MPEP 706.03(c) elaborates, instructing that a claim is not to be rejected under 35 USC 112, first paragraph, when that claim is described “in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

MPEP 2163.04 instructs that the burden is on the examiner with regard to the written description requirement, stating that “[t]he examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” In doing so, “the examiner must set forth express findings of fact... [i]dentify the limitations at issue...” and “[e]stablish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.”

Applicant respectfully submits that in light of the citations and remarks presented, the Examiner cannot meet this burden. Figure 3 of the Specification and its related description provide explicit support of for the recited claim language. “As discussed above, a player 120 **may pay** for the game **or** obtain access to the game through **AMOE**.” (Specification p. 18, lines 7-8). As is further shown in Figure 3, **any number** of players (120) may play at least one game piece 118 which can be one or more game cards (100) to be entered into a game session 122. (Specification p. 18 lines 4–16).

For purposes of illustration Fig. 3 has been included. Upon review of Fig. 3 and its related description one of skill in the art would recognize that a player may enter into a game using either a pay method of entry into a game session 122 of the game (“a player **may pay** for

the game” Specification, p. 18, lines 7-8) or use an AMOE to enter the same game session 122 (“or obtain access to the game through AMOE” Specification, p. 18, lines 7-8). In particular one of skill would recognize that Fig. 3 illustrates a first player 120 (for the purposes of clarity reference characters “**A**” and “**B**” have been added) entering the game session 122 using a method of his/her choosing - AMOE or payment method. As the description of Fig. 3 reads “[a]s discussed above, a player 120[**A**] may pay for the game or obtain access to the game through AMOE.” The illustration of another player **B** leads one of skill in the art to the conclusion that another player **B** is permitted to enter the same game session 122.

Indeed as Fig. 3 illustrates using three dots to the left of player **B**, “the three dots denote when an item may proceed ad infinitum.” (Specification, p. 18, lines 5-6). One of skill in the art would understand, a large number of players may in fact enter the same game session 122. As described, player 120**A** is given the choice to enter the game session by paying or AMOE. The natural conclusion is that the other player, denoted **B**, is provided the same choice. In fact, one of skill in the art would review Fig. 3 and understand that each and every player denoted by the three dots in Fig. 3 is given the same choice as is described explicitly with respect to player 120**A**. (“a player 120 may pay for the game or obtain access to the game through AMOE.” (Specification p. 18, lines 7-8)).

To read the Specification as is alleged by the Examiner – one would have to interpret the Specification to read *only* player 120 may enter the game session at 122 by payment or AMOE, every other player that participates in the game session entered by player 120 must enter the game session using whatever method was selected by the first player, 120, to enter the game session and no other. This reading *cannot* be what one of skill in the art would reasonably appreciate from the Applicant’s disclosure.

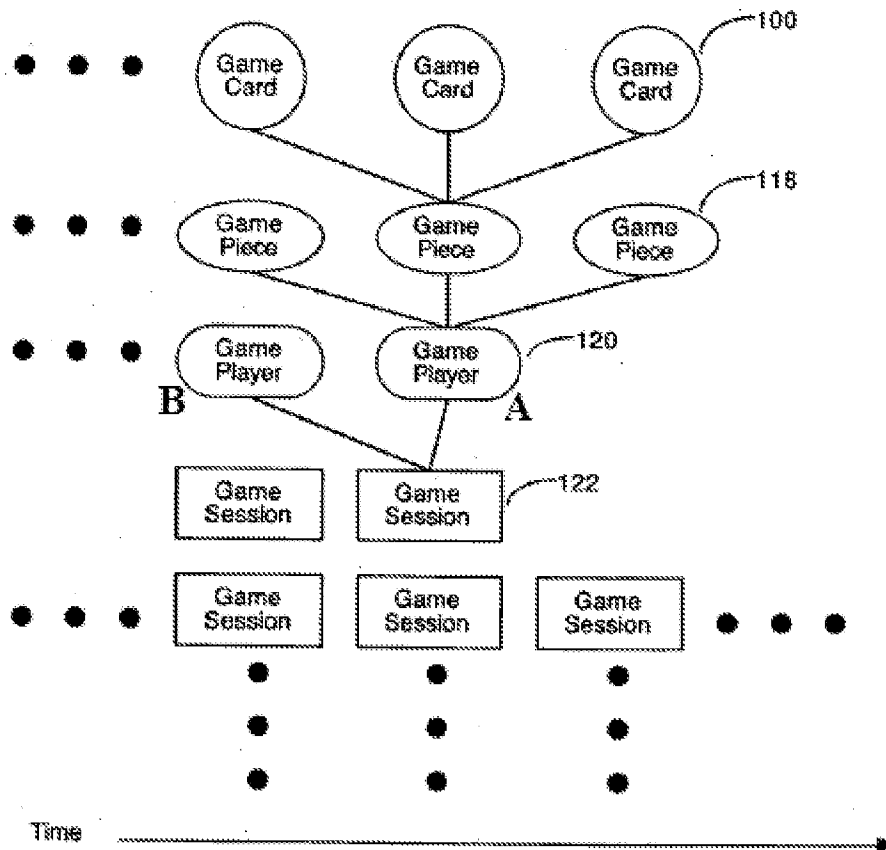


Figure 3

Further incorporated by reference is Applicant's Provisional Application, Serial No. 60/431036. On page 13, of the Provisional Application it states with reference to Fig. 3:

Each player 120 *may pay* for the game *or* obtain access to the game through AMOE ... and thus play at least one game piece 118 for *a particular game session 122*. (lines 21-23).

In light of the explicit recitation that "each player ... may pay or obtain access ... through AMOE ... for a particular game session," (see Fig. 3, 122) withdrawal of the rejection is respectfully requested.

Further, Applicant respectfully submits in the first instance – stated generally - that the alternative method of entry into the game is exactly what the word alternative conveys. In order to be an alternative – it must be an alternative to something. The very nature, wording and the

totality of the Specification leads one of skill in the art to the opposite conclusion presented by the Examiner – namely a payment method of entry is provided and an alternative method of entering the same game is also provided. Secondly, the Specification consistently refers to a “wagering game” that includes AMOE entry. AMOE entries are not wagers. (Specification, p. 18, lines 7-8). Thus in order to have a wagering game, there must be some form of entry accompanying any AMOE entry that comprises a wager.

Reference to the game as a “wagering game” (p. 3, 4, 5, 6, 7 – to highlight only portions of the Summary) occurs throughout the Specification. One of ordinary skill would understand that the game must include a wager in order to be a wagering game. The Specification couples the description of “wagering game” with an alternative method of entry (see e.g. AMOE – p. 5, 6, 7, 8, 12, 13 and 14 – again highlighting only portions of the Summary). The claims as originally filed also link “wagering game[s]” with AMOE entries. (Please see e.g. Claim 12, see also e.g. Claim 104 of Provisional Application 60/431036, incorporated by reference).

AMOE entries are “not considered wagering or gambling.” (Specification, p. 18, lines 7-8). Thus, in order to have a wagering game, there must be some form of wager collected. One of skill in the art would readily appreciate that the disclosed wagering game with AMOE describes both payment and AMOE type of entries into the same game. As is further discussed in the Specification, the game may have one game session. (Spec, p. 3, line 22). Therefore, one of skill in the art would readily understand that a “wagering game” having one game session and two types of entry, payment and AMOE, would provide for a player to enter the game and its one game session using either method.

The Applicant provides the additional examples below that necessitate the withdrawal of the rejection. On page 27, the Specification describes “[o]ne system component [that] handle[s] *payment*, subscription *and/or* AMOE by players to enter game sessions.” (Lines 18-19). The use of the word “and/or” when referring to payment, subscription *and/or* AMOE to enter game sessions, necessarily results in the conclusion, that one may enter the game session using any one or all of the three listed methods of entering, and the system component described can accommodate any one or all of the three listed methods to enter players in one or many game sessions.

Page 17 of the Specification, “[a]ccording to one embodiment of the invention, players may also enter to play *this or any other wagering game* of chance using an alternative method of

entry (AMOE). (Lines 22-23). The previously described game referred by “this ... wagering game of chance” explicitly discloses paying for an entry, “prior to a game session, a game player may need to pay for playing ... payment may be in any form that is legal in the particular jurisdiction.” (Specification p. 17, lines 3 and 12-13). Further, the reference to “any other wagering game of chance” must necessarily include the wagering games of chance described in the preceding and subsequent sections of the Specification.

Additionally, the Specification describes constraints imposed on the AMOE entry that if read in isolation as the Examiner suggests, would not appear to be reasonable. Again with reference to the players who enters to play this or any other wagering game of chance using an alternative method of entry, the Specification further describes that “[a]n individual entering a sweepstakes by AMOE is required by law to have the same odds of winning each of the available prizes.” Specification, p. 17, lines 25-27. What one skilled in the art would readily appreciate – players entering in the game session by AMOE must by law have the same odds of winning as players who enter the game session via a payment method of entry. The Specification also discusses limiting the number of AMOE entries into any particular game. (See Spec, p. 17 lines 23-25 – “The wagering game of chance player entering by AMOE may also be limited to a small number of game sessions within a given period of time, for example one game session in one year or two game session in one month.”). The limitation is imposed to preserve fairness across the entrants who enter by payment and players who enter by free. Absent the combination of payment entry and AMOE entry the limitation makes little, if any sense. Limiting players to one game session entry in a year – if not conducted in conjunction with another game entry method as the Examiner alleges – leads to a game that may only be conducted once a year. This does not appear to be a reasonable interpretation in light of the Applicant’s Specification.

Further examples may be found throughout the Specification, and in particular, the description of a game having one game session (p. 3, line 22), a game having a plurality of game sessions (p. 3, lines 1), with the game being a wagering game of chance (p. 3, lines 6-7). “Providing for an entry of at least one player in the game, and providing, to the at least one player, an alternative method of entry (AMOE) to the game.” (p. 6, lines 26-27). Other examples include where, the wagering game has multiple game sessions (p. 3, lines 28-29) including payment methods of entry (e.g. p. 3, lines 16-17; p. 29, lines 22-23) and subscriptions

into multiple game sessions (p. 3, lines 28-29) and *another* method of entry into the game (see e.g. p. 5, lines 6-8), describing the *alternative* method of entry in to a game session (p. 5, lines 14-17). AMOE entries may also provide for entry for “at least two game sessions.” (p. 5, lines 28-30).

One of skill in the art would understand that an AMOE entry that provides for an entry into *at least two* game sessions would include AMOE entries into a minimum of two game sessions and up to the total number of game sessions in the particular game. Wherein the game is a wagering game of chance, (e.g. p. 5, line 21) at least one of those game sessions must include a wager. Therefore, there must, based on the Applicant’s disclosure, be at least one game session entered by AMOE where at least one wager is collected (pay method of entry).

On page 8: [a]ccording to another aspect of the present invention, a game is provided having *an associated game session*, the game comprising one or more game pieces assigned to each player, wherein each game piece includes one or more game cards, wherein each of the one or more game cards includes a plurality of cells arranged in a pattern, wherein each of the one or more game pieces includes a set of game cards having a same set of game patterns, and wherein the calls of each of the one or more game cards contains content chosen randomly from a predetermined set of cell content, a winning cell matching pattern for the game session, a fixed number of winning cell content drawn from a known set of content, and a payout based upon a predetermined payout table.

On page 9 (with reference to the same aspect): [a]ccording to another embodiment of the present invention, the player pays to play with at least one of money and loyalty points. (lines 12-13). On page 12 (with reference to the same aspect): [a]ccording to another embodiment of the present invention, the player may enter a game session through an alternative method of entry (AMOE). According to another embodiment of the present invention, the game and its associated game session are played using one or more computer systems. One of skill in the art, with the benefit of the Applicant’s disclosure, would readily appreciate that the cited portions of the disclose cover a game with one (in addition to many) game session that may be entered by paying (p. 9, lines 12-13) or by AMOE (p. 12, lines 9-12).

Referring again to page 17: “[a]ccording to one embodiment of the invention, it is realized that an AMOE (alternative method of entry) may be used to enter a game of chance. More particularly, it is possible to develop, implement and run wagering games of chance,

including *the inventive games described herein*, with an AMOE method of entry.” (Lines 16-18). The Specification explicitly couples the use of AMOE with the disclosure relating to games having payment methods of entry.

The Examiner appears to have cited to Para. 0022 of the published application for the proposition that the Applicant has somehow limited the scope of the disclosure. However, there is no disclaimer in Para. 0022, nor is there description that limits the invention as alleged. Para 0022 recites:

According to another embodiment of the present invention, the AMOE is performed by an act of submitting an entry to the wagering game by mail. According to another embodiment of the present invention, the AMOE is performed by an act of submitting an entry to the wagering game over the Internet. According to another embodiment of the present invention, a game session associated with the wagering game is provided with an entry by AMOE. According to another embodiment of the present invention, the game session entered is the next starting game session after the AMOE is received and logged by the game operator. According to another embodiment of the present invention, the game session entered is the next starting game session designated for AMOE game players after the AMOE is received and logged by the game operator. According to another embodiment of the present invention, the wagering game is a wagering game of chance.

First, Para. 0022 discusses only examples of the present invention. It does not limit the scope of the disclosure. Second, Para 0022 is preceded by the description that provides for a “wagering of chance” that is entered by a pay method of entry (see e.g. para. 0014). Para. 0022 describes an “AMOE” – that is an *alternative* method of entry. Describing the method of entry as an “alternative” must necessarily contemplate an alternative to something. One of skill in the art would readily understand that an alternative was being provided to the previously described examples, including payment methods of entry. Third, Para. 0022 explicitly refers to a “wagering game of chance” and thus must necessarily include a wager (a pay method of entry).

Fourth, the Examiner has improperly interpreted “[a]ccording to another embodiment of the present invention, the game session entered is the next starting game session after the AMOE is received and logged by the game operator,” to exclude payment methods of entry. The disclosure indicates that a game session may be designated for entry by AMOE. No exclusion is disclosed. Even assuming for the purposes of argument that embodiment disclosed excludes pay methods of entry from those game sessions “designated for entry by AMOE,” the preceding embodiment, which describes entry into “the next starting game session” does not recite any

designation. Thus, one of skill in the art would understand that the next starting game session does not have any limitation with respect to the type of entry.

The disclosure in para. 0022 mirrors the language of the claims as originally filed in Provisional Application 60/431,036. In particular claims 77 and 78 recite:

77. A wagering game of chance of claim 72, wherein the game session entered is the next starting game session after the AMOE is received and logged by the game operator.

78. A wagering game of chance of claim 72, wherein the game session entered is the next starting game session designated for AMOE game players after the AMOE is received and logged by the game operator.

One of skill in the art would readily appreciate that the scope of claim 77 must be broader than the scope of claim 78 describing first “the next game session” and in claim 78 “the next game session designated for AMOE.” If for the purposes of argument one were to read claim 78, to exclude payment methods of entry from a game session designated for AMOE, one must read claim 77 not to exclude payment methods of entry as it does not contain the limiting language regarding designation of the next game session. Upon a reasonable reading of the Specification, must conclude that it was the intent of the Applicant to claim something different by providing claim language of different scope and wording.

Therefore, in light of the explicit recitation of Fig. 3, the incorporation by reference, and the entirety of the Specification which describes payment methods of entry and their alternatives used in the same game – a game which may have one game session, the preponderance of the evidence supports only one conclusion and necessitates withdrawal of the rejection.

The Applicant respectfully notes that the rejected claim language was first introduced by amendment on November 2, 2008. The submission to then Examiner Benjamin William Lee did not draw any rejection based on U.S.C. §112. Subsequent actions on February 2, 2009 and the Advisory Action issued May 27, 2009, failed to note this ground of rejection. Applicant respectfully submits that failure to raise this ground of rejection under §112 is indicative of a reasonable interpretation of the Specification that provides the necessary support for the pending claims.

The Office Action rejected claim 36 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement, additionally, the Office Action rejected claim

36 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Office Action alleges that is unclear what the Applicant is intending to claim as it is unclear how one would wager in a jurisdiction where gambling is illegal or violates common law.” (Office Action, p. 3). Applicant has amended claim 36 to clarify what the Applicant regards as the invention.

Claim 36, as amended, recites, the method of claim 1, wherein the at least one player enters the wagering game from at least one jurisdiction in which wagering is not permitted.

As the Specification recites: “AMOE methods ... are not considered wagering or gambling.” (Specification p. 18, lines 7-8). “Thus according to one embodiment of the invention, an individual may enter a wagering game of chance by AMOE.” (Spec. p. 18, lines 8-10).

Applicant respectfully submits as disclosed - that one may participate in a wagering game using AMOE methods of entry even in jurisdictions where wagering is not permitted because AMOE entries “are not considered wagering or gambling.” (Spec. p. 18, lines 7-8). Applicant respectfully submits that “the at least one player enters the wagering game from at least one jurisdiction in which wagering is not permitted” can occur where wagering is not permitted because of the non-wagering form of entry provided as an AMOE. Accordingly, withdrawal of the rejection of claim 36 under 35 U.S.C. §112, first and second paragraph, is respectfully requested.

Rejections Under 35 U.S.C. §103

The Office Action rejected claims 1-2, 4-10, 12-14, 16, 18-20, 22-23, 26-31, 33-34, and 36-43 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Fisk in view of Itkis.

The Office action recites that claims 1-2, 4-10, 12-14, 16, 18-20, 22-23, 26-31, 33-34 and 36-43 are rejected under section §103, however, in the description of the §103 rejection the Office Action indicates that the claims are also rejected under §102. It is the understanding of the Applicant that the Examiner has based his rejection on the combination of Fisk and Itkis. If this understanding is not correct, Applicant invites the Examiner to re-issue the Office Action

and address the Applicants remarks with respect to Fisk and how Fisk does not teach providing an AMOE for free. Presently the Office Action has dismissed the Applicant's remarks as moot.

In order to forward prosecution, Applicant provides the following remarks as to the alternative §102 rejection of the claims over Fisk. Claim 1 recites in pertinent part “an alternative method of entry (AMOE) to the at least one game session of the wagering game, wherein the alternative method of entry provides a free method of entry into the at least one game session of the wagering game, wherein the alternative method of entry (AMOE) is provided for free.” There is no teaching in Fisk that can be found to support the argument that Fisk discloses a method for entering the game of Fisk, wherein the method of entering is provided for free.

The Office Action cites to instant win tickets as providing the teaching for the alternative §102 rejection. “[I]nstant win tickets provide the holder a free entry into the bingo game using the bingo card printed on the instant win ticket (Page 13, lines 30-Page. 14 , lines 1-12).” (Office Action, p. 5). “The above clearly implies at least as much that one player may purchase entry into a bingo session and another may used a free alternative entry into the bingo game session.” (Office Action, p. 5). Even assuming the implication alleged is correct, for the purposes of argument, the Office Action fails to address where Fisk teaches that the “alternative method of entry (AMOE) is provided for free,” as recited in claim 1.

In addition, by citing to what may be implied from the disclosure in Fisk, it appears that the Examiner has exceeded the scope of what is permissible in §102 rejection. As stated in the M.P.E.P. § 2132: “TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM.” “‘A claim is anticipated *only* if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).” M.P.E.P. §2132 (emphasis supplied). The Office Action fails to indicate where in Fisk it is either explicitly or inherently disclosed that an “alternative method of entry provides a free method of entry into the at least one game session of the wagering game” and “the alternative method of entry (AMOE) is provided for free.”

Therefore, Applicant respectfully requests withdrawal of the alternative ground of rejection under §102.

In addition, Fisk does not teach or suggest that the “alternative method of entry (AMOE) does not comprise a wager,” as recited in claim 1, as amended. Fisk discloses a computer network which manages multiple simultaneous bingo games having a potentially large number of bingo cards and managing the computational burden associated with the multiple simultaneous bingo games. (Fisk; Abstract, and p. 5, lines 6-19). Fisk also provides the ability of a player to participate in the bingo game by validating a bingo card received from a number of possible sources. (Fisk, p. 8 lines 12-13). Specifically, pre-printed bingo cards are distributed electronically to public locations, in advance of the game, for example through lottery networks to lottery machines, through ATM networks to ATMs, or by printing bingo cards in available spaces on instant lottery game pieces. (Fisk, p. 8 lines 13-16). “A player, having chosen a preferred pre-printed card, can then validate the card to participate in a bingo game by submitting payment for the game, and the identifier of the card (which may be typed or bar-coded onto the pre-printed card). (Fisk, p. 8 lines 20-22).

In every method of entry disclosed, Fisk accepts a wager from a player, permitting participation in the bingo game. (Please see Fisk, p. 10 lines 5-13 (ATM permit sales and redemption); p. 10, lines 35-28 (Lottery terminals used to purchase cards and/or validate previously purchased or obtained cards); p. 10, lines 28-31 (lottery system includes player accounts and/or retail accounts to be debited and credited as games are played); p. 12, lines 27-29 (When using ATM network player will pay to enter via an account or credit card number); p. 12, lines 31-32 (using the Internet or voice response server player uses a payment account) ; p. 13, lines 1-3 (credit lines); p. 13, lines 4-6 (fees charges to telephone bill); p. 13, lines 9-11 (finally player may use a lottery terminal); and p. 14, lines 9-11 (winning an entry from an instant win ticket).

Fisk discloses methods of entering a bingo game that comprise wagers. Therefore, Fisk cannot teach, suggest or disclose an “alternative method of entry (AMOE)” that “does not comprise a wager.”

Claim 12 and 25, as amended, also require an “alternative method of entry (AMOE) is provided for free” and the “alternative method of entry (AMOE) does not comprise a wager.” Therefore claims 12 and 25 are allowable for at least the same reasons discussed above. Dependent claims 2, 4-10, 13-14, 16, 18-20, 22-23, 26-31, 33-34 and 36-43 depend from one of

independent claims 1, 12, and 25, and are allowable for at least the same reasons. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. §103

The Office Action rejected claims 1-2, 4-10, 12-14, 16, 18-20, 22-23, 26-31, 33-34 and 36-43 under 35 U.S.C. §103(a) as being unpatentable over Fisk WO00/69535 (hereinafter Fisk) in view of Itkis et al. U.S. Publication No. US2003/0171986 A1 (hereinafter Itkis).

As discussed above, Fisk discloses a bingo game that permits entry by accepting wagers from participating players. (Please see Fisk, p. 10 lines 5-13; p. 10, lines 35-28; p. 10, lines 28-31; p. 12, lines 27-29; p. 12, lines 31-32; p. 13, lines 1-3; p. 13, lines 4-6; p. 13, lines 9-1; and p. 14, lines 9-11.)

Itkis, in contrast, teaches a game that provides only free entries into a bingo style game. Itkis provides commercial establishments, such as bars, pubs, and clubs with an effective promotional tool capable of attracting patrons while extending patrons' visits. (Para. 0006). Itkis teaches that in a majority of jurisdictions, bars and similar establishments are legally precluded from selling bingo cards to patrons. (Para. 0003). Itkis describes an object of the invention is to provide such games in a legally permissible manner. (Para. 0009). Another object disclosed is to provide funding for such *free* promotional games from commercial sources. (Para. 0010). Itkis teaches that *the objects of the present invention* are achieved by conducting linked large-prize bingo games simultaneously *at no cost* to patrons of the establishments and *in compliance with free sweepstakes laws and regulations*. (Para. 0012, emphasis supplied).

In summary, Itkis, et al. discloses providing *exclusively* a free method of entry into a linked promotional bingo game. (Please see e.g. Para. 0013; and Para. 0020). Itkis teaches that the free method of entry *is the only method that satisfies the objects of the invention*, which include deriving sources of funding for the free game. (Please see e.g. para. 0012).

Thus, the disclosure of Itkis explicitly teaches away from the modifications proposed by the Examiner and further Itkis teaches away from a combination with any reference that includes a pay method of entry. "The above objectives of the present invention are achieved by conducting linked large-prize bingo games ... *at no cost* to patrons and in compliance with free sweepstakes laws and regulations." (Col. 2, para. [0012])(emphasis supplied). Itkis teaches that one of skill in the art would look to implement a bingo game in this setting as a free only game,

and further that one of skill in the art would be cognizant of gaming regulation when seeking to implement such a game. (Please see Itkis, Col. 2, paras. [0012] and [0002]). The teachings of Itkis in this context are relevant to the combination proposed by the Examiner ***and must be considered***. See MPEP § 2141.02 (prior art must be considered in its entirety, including disclosures that teach away from the claims) citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) (A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.).

As further stated in the M.P.E.P. §2143.01 sec. V:

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART
UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The modification proposed by the Examiner is explicitly contrary to the stated objectives of the invention.

Further M.P.E.P §2143.01 sec. VI instructs:

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF
OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

A modification the explicitly contrary to the stated objects of the invention must change the principle of operation of the reference, and as such, cannot be proper.

During the course of the Interview, Examiner Harper indicated that the recitation in Fisk regarding the “distribution of preprinted bingo cards is expected to enhance visibility of the bingo game and promote sales of the bingo game” would lead one of skill in the art to infer that

one would combine a promotional game with the teachings of Fisk. (See Fisk, p 14, lines 5-11). Applicant respectfully disagrees. The only reference to promotion in Fisk comes in the form of “promot[ing] sales” by distribution of preprinted cards. This suggests that distributing cards is the vehicle by which one would promote sales. It does not suggest promotional gaming as is alleged.

Further Fisk contemplates “bingo cards ... preprinted on instant win tickets ... distributed by state lotteries ... may be readily used to advertise and encourage participation.” (Fisk, p. 14, lines 7-9). Again Fisk suggests that card distribution may be used to advertise – nothing in Fisk suggests promotional gaming as has been alleged by the Examiner.

Fisk uses lottery distribution systems to provide bingo cards, for example “bingo cards may be sold in the same manner as instant win tickets.” (Fisk, p. 14, lines 14-15). Additionally, Fisk also discusses the use of winning outcomes on instant win tickets, to provide free entries to the bingo game. The Examiner alleges that is irrelevant whether a player pays for the instant win ticket and upon winning is given a “free” entry. (Office Action, p. 11). Applicant respectfully disagrees. If a player pays for a scratch ticket and is awarded a \$10 prize, no one (of skill or otherwise) would suggest that the \$10 prize has been provided for free, as the player was provided access to the prize based on the initial purchase of the scratch ticket. Fisk suggests replacing a winning outcome (having a dollar value) with another winning outcome having a value (the ordinary cost of an entry). Fisk does not suggest promotional gaming, as alleged.

As Itkis teaches away from the combination proposed by the Examiner, the proposed modification defeats the stated objects of the reference, and modifies its fundamental operation the combination proposed is not proper. Even assuming the combination feasible and proper, the combination of Fisk and Itkis does not result in the claimed invention, as alleged. Neither Fisk nor Itkis alone or in combination teaches, discloses or suggests a “game session” of a “wagering game” with “an alternative method of entry” “provided for free” that “does not comprise a wager,” as recited in the independent claims. Rather the reasonable result of the combination would yield two separate games. A wagering game as taught in Fisk combined with a separate free only game as taught in Itkis. Only in such a setting can the teachings and the explicit objects of the invention of the prior art be preserved. Last, the combination of Fisk and Itkis suggests nothing with respect to providing individual game sessions having wagering style entries and AMOE entries. Each reference teaches a game in isolation, the game sessions in both have their

own individual methods of entry, nothing in either reference teaches or suggests the integration of the individual game sessions. Thus the combination of the two cannot teach anything with respect to individual game sessions having wagering style entries and AMOE entries.

The Office Action rejected claims 3, 15, 21 and 32 under 35 U.S.C. §103(a) as being unpatentable over Fisk in view of Itkis. Applicant respectfully traverses this rejection.

As discussed above, the combination is improper and even if assumed proper, the combination fails to disclose teach or suggest the independent claims from which 3, 15, 21, 32 and 36 depend, as Scott does not teach “the alternative method of entry (AMOE) is provided for free” and “the alternative method of entry (AMOE) does not comprise a wager,” as recited in claims 1, 12 and 25. Therefore, claim 3, 15, 21, 32 and 36 are allowable for at least those reasons. Furthermore, Applicant respectfully disagrees with the Examiner’s allegations regarding mere design considerations.

It appears that the Examiner may be attempting to take Official Notice that there is no patentable difference between games of chance and games of skill. MPEP 2143.03A instructs that official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well known. The MPEP 2143.03A states that “[i]t is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which the rejection was based.” Thus Applicant respectfully requests that the Examiner either provide a reference teaching the elements of the claim or withdraw the rejection.

Second, one of skill in the art would readily understand that games of chance and games of skill are fundamentally different. Third, the Examiner alleges that “it appears that the gaming system of Fisk ... would perform the same function of providing a Bingo gaming system with a primary entry means as well as the alternative entry means regardless of the type of game being played.” Applicant respectfully disagrees. Fisk explicitly recites and discloses operations that are performed solely in the context of a Bingo game. (See e.g. Abstract - “Bingo cards distributed in the network in accordance with number of hits,” “one away computers,” “two away computers,”). It appears the Examiner is proposing ignoring the context in which Fisk provides its disclosure, which is improper. Moreover, it appears the Examiner is disregarding

the teaching in Fisk explicitly reciting how to handle the various aspects of the bingo game disclosed – for example the one away computers and two away computers – and how the systems disclosed manage the computational burdens associated with operating a large ongoing *real-time* bingo game. (See e.g. Fisk, p. 5 lines 7-10, 21-29). Fourth, one of skill in the art would not view the wholesale substitution of another game for the game disclosed in Fisk as feasible, advisable or even obvious.

Last, one of skill in the art would readily appreciate the difference between the use of mail and the use of, for example, the internet. One of skill in the art would not look to replace an electronic communication system with one that relies on the Post Office, nor would it be obvious to do so.

The allegation in the Office Action citing to mere design consideration ignores the context of the references being relied on and in addition fails to consider the claimed invention as a whole, both are required. (See MPEP §2141.02 sec. VI and sec. I).

The Office Action rejected claims 11, 17, 24, and 35 under 35 U.S.C. §103(a) as being unpatentable over Fisk in view of Itkis and in further view of Scott et al., U. S. Patent No. 6,102,400 (hereinafter Scott). Applicant respectfully traverses this rejection.

Scott does not cure the deficiencies discussed above with respect to the combination of Fisk and Itkis and the independent claims from which claims 11, 17, 24 and 35 depend, as Scott does not teach or suggest “an alternative method of entry” “provided for free” that “does not comprise a wager,” as recited in the independent claims from which they depend. Therefore they are allowable for at least those reasons.

Moreover, Scott discusses a bonus payout (a “bad beat” bonus payout) with respect to play of conventional keno games. (Abstract). In Scott, each player makes an initial ante wager to be eligible to play the game. (Col. 4, lines 12-13). Each player also has the option to make a side bet wager to be eligible for the “bad beat” feature. (Col. 4, lines 15-17). Alternatively, the player does not need to make a side bet to participate in the “bad beat” bonus, rather the initial entry is sufficient. (Col. 7, lines 39-43). In summary, Scott requires payment in order to win the “three free games” (Col. 10 lines 4-5) cited in the Office Action. (See Office Action, p. 7).

Therefore, Scott cannot cure the deficiencies discussed above with respect to the combination of Fisk and Itkis. Moreover, Scott teaches away from the use of an alternative

method of entry that is provided for free and from an alternative method of entry that does not comprise a wager by requiring payment. Last the alleged combination of Fisk, Itkis and Scott does not teach or suggest “the alternative method of entry (AMOE) is provided for free” and “the alternative method of entry (AMOE) does not comprise a wager,” as recited in claims 1, 12 and 25.

Inherency: Claims 8 & 28

The Office Action rejected claims 8 and 28 under 35 U.S.C. §103(a) as being unpatentable over inherent characteristics of Fisk in view of Itkis. Applicant respectfully traverses the rejection.

As set forth in MPEP Section 2112:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

The Office Action alleges “e.g. the instant win ticket would have to designate entry into the bingo session (see above).” (Office Action, p. 6, Claims 8 & 28). As discussed above in the Office Action, the Examiner makes clear he is relying on capability and not necessity. As alleged, “[t]he system is **capable** of processing the next game session via AMOE for the respective players.” (Office Action, p. 6, Claims 7,-18-19, & 27) (emphasis supplied). This is not sufficient to establish inherency. Nothing disclosed in Fisk establishes that “an indication of a game session to be entered by the alternative method of entry (AMOE),” is **necessarily present**. Indeed, as discussed above, Fisk makes clear a game card identifier coupled with some form of payment is sufficient to permit entry into the bingo game without more. (Please see Fisk, p. 10 lines 5-31, p. 12 line 27 – p. 13 line 11, and p. 14 lines 1–3 and 9-11). Thus, anything else cannot be considered necessarily present. For at least these reasons the rejection of claim 8 and 28 should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, reconsideration is respectfully requested. This application should now be in condition for allowance; a notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an accompanying payment, please charge any deficiency to Deposit Account No. 50/2762, Ref. R0586-701110.

Respectfully submitted,

Mark E. Herrmann et al., Applicants

By: /Matthew H. Grady/
Matthew H. Grady, Reg. No. 52,957
Edward J. Russavage, Reg. No. 43,069
LANDO & ANASTASI, LLP
One Main Street
Cambridge, Massachusetts 02142
Telephone: 617-395-7000
Facsimile: 617-395-7070